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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/786,903	05/09/2001	Jens Stefan Schneider	10191/1714	7920
26646	7590	04/01/2004	EXAMINER	
KENYON & KENYON			OLSEN, KAJ K	
ONE BROADWAY			ART UNIT	
NEW YORK, NY 10004			PAPER NUMBER	

1753

DATE MAILED: 04/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No. 09/786,903	Applicant(s) SCHNEIDER ET AL.	
	Examiner Kaj Olsen	Art Unit 1753	<i>eb</i>

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 09 February 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 10-29.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

DETAILED ACTION

1. Applicant's arguments filed 3-15-2004 have been fully considered but they are not persuasive. With respect to the lack of enablement concerning the ceramic component, it appears that applicant wishes claim 10 to be interpreted in a manner where the metal oxide is the specified ceramic component of the claim. However, applicant's reading of claim 10 does not mesh with what the claim is literally saying. The claim states that the cermet electrode includes a metal oxide, a metallic component, and a ceramic component. This literally reads as if the electrode includes those three components separately of each other. The claim never states that the ceramic component of the cermet is the same thing as the metal oxide. Moreover, the examiner also cannot find anything in the specification that states that the ceramic component of the electrode is the same thing as the mixed oxide. In fact, it doesn't appear that the metal oxides are ever specified as even being ceramics. Applicant cannot explicitly recite three components in a claim and leave it up to the interpreter of said claim to determine that the drafter of said claim actually meant for two of the components to be construed as being the same thing. Absent any specific recitation in the claim that the ceramic component and the mixed oxide are the same thing, a fair reading of claim 10 would be an electrode that comprises the specified three components. If the applicant wishes for the ceramic component of claim 10 to read on the various set forth metal oxides, then the claim needs to make this clear that they are the same thing. At that point, the enablement rejection of the "ceramic component" would be withdrawn. However, such an amendment might raise new issues with respect to the prior art because applicant would be going from the recitation of three components to two components.

Art Unit: 1753

2. With respect to applicant's "rule" that metal oxides are ceramics, the examiner is not aware of any rule establishing that. Regardless of whether or not this is true, applicant has never made this clear in either the claims or the specification.

3. With respect to the enablement rejection of the "metallic component", applicant urges that silver and gold are the disclosed metal components. How can silver and gold be construed as the metal component of claim 10 when claim 13 states that the electrode "*further* includes a metal component" (emphasis added) of silver or gold? Claim 13 does not specify that the silver and gold are the "said metal component" of claim 10. The silver and gold of claim 13 is not the metal component of claim 10 because the electrode only further comprises these metal components. Again it appears that applicant wishes the claim language to be interpreted in a manner that the literal interpretation of the language would not have arrived at.

4. With respect to claim 20, the cited passage in defense of the claim (specification p. 8, lines 7-11) does not provide originally filed disclose support for the claim. Nowhere in that passage does it say that the electrode materials of claim 20 could be combined with the materials of claim 12. Nothing in the passage gives any indication that mixtures of the various components are possible, only that the electrode could include the materials of claim 20 or the materials of claim 12. The examiner contends it may have been obvious in view of the disclosure to utilize a combination of the materials of claim 12 and 20, but new matter determination is not based on what would have been obvious, but rather what did the applicant originally convey the invention to be. The applicant never conveyed that a mixture could be utilized.

Art Unit: 1753

5. With respect to the remaining arguments, applicant provides a number of broad arguments concerning the appropriateness of lack of enablement rejections. However, these argument appear to be irrelevant in view of the specific issue here. Namely, that the applicant wishes the claim language of claims 10 and 13 be interpreted in manner that reads away from what the claims are actually stating.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kaj Olsen whose telephone number is (571) 272-1344. The examiner can normally be reached on Monday through Thursday from 6:30 A.M. to 4:00 P.M. and on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam Nguyen, can be reached on 571-272-1342. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Kaj Olsen', with a long horizontal flourish extending to the right.

Kaj Olsen Ph.D.
Primary Examiner
AU 1753
March 29, 2004